



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097026,400	02/19/98	MURI	S 2185-0226P-S

HM12/0625
BIRCH STEWART KOLASCH & BIRCH
PO BOX747
FALLS CHURCH VA 22040-0747

EXAMINER
ZAGHMOUT, O

ART UNIT	PAPER NUMBER
1649	

DATE MAILED:

06/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/026,400

Applicant(s)
Mori et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on Feb 19, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Notice to comply with sequence requirement.

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

III. Claim 1 is drawn to a protein, classified in class 530, subclass 300, for example.

I. Claims 2-13 are drawn to nucleic acid molecule encoding a protein, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 278 for example.

II. Claims 14-20 are drawn to less than full length gene, classified in class 536, subclass 24.3 for example.

2. The inventions are distinct, each from the other because each is drawn to molecularly and biochemically divergent products and processes not required by the other.

a. The invention of group I involves an isolated protein not required by any other group. Furthermore, the protein could be made by a process other than the expression of the gene of group I, such as chemical synthesis.

b. The invention of group II involves a full length gene not required by any other group, and methods for plant transformation and regeneration not required by groups I and III. Furthermore, the gene of group II can be used to express a gene in a transgenic plants, whereas the gene fragment of invention of group III can be used only as a probe, not for expression in a transgenic plant.

Art Unit: 1649

c. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR.148(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and the fee required under 37 CFR 1.17(h).

Art Unit: 1649

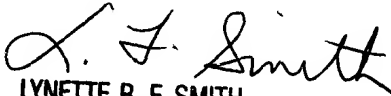
Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.
June 20, 1999


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600